

REMARKS

This is a full and timely response to the outstanding non-final Office action January 5, 2005. The Examiner has required the Applicant to elect to prosecute one of three groups of claims identified in the Office Action. In response to the restriction requirement, Applicant respectfully elects to prosecute the claims of Group I, corresponding to claims 1-9, with traverse, as set out hereafter.

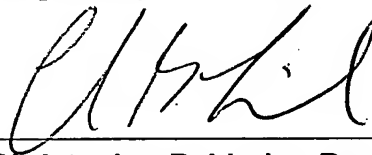
First, in the interests of equity and fairness, Applicant should be entitled to pursue different method claims in the present application, particularly, method claims for determining the presence of biomolecules using SERS. The restriction requirement is unfair to the Applicant, because it will require the Applicant to file and bear the additional cost and time delay associated with filing one or more divisional or continuing applications in order to cover each claim set.

Second, as provided in 35 U.S.C. § 121, restriction to one of two or more claimed inventions is proper only if the inventions are "independent and distinct." In its discussion of the propriety of restrictions, MPEP § 803 further provides that if search and examination of two or more inventions can be made without "serious burden," the Examiner must examine them on the merits even if the claims are directed to distinct or independent inventions.

In the present case, Groups I and II, although not necessarily obvious in view of each other, are very similar in subject matter. More specifically, each pertains to determining the presence of biomolecules using SERS. Applicant respectfully submits that a search for the method of determining the presence of biomolecules using SERS in Group I would inherently result in a search of the method for determining the presence of biomolecules using SERS in Group II. For this reason, Applicant respectfully submits that the inventions described in these claims are not "independent" as defined in MPEP § 803 and that the restriction requirement therefore is improper as between Groups I and II.

For at least the foregoing reasons, Applicant respectfully traverses the restriction requirement and respectfully requests the Examiner to examine the claims of Groups I and II together. In the alternative, Applicant respectfully requests the Examiner to examine Group I, Claims 1-9 drawn to a method of determining the presence of biomolecules using SERS. Applicant expressly reserves the right to present the non-elected claims, or variants thereof, in continuing applications to be filed subsequent to the present application. Should the Examiner have any questions regarding this response, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. B. Linder', written over a horizontal line.

Christopher B. Linder, Reg. No. 47,751

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.

Suite 1750

100 Galleria Parkway N.W.

Atlanta, Georgia 30339

(770) 933-9500